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DONALD J. POCHOPIEN
MCANDREWS, HELD, & MALLOY, LTD
CITICORP CENTER, 34TH FLOOR
500 WEST MADISON STREET
CHICAGO IL 60661

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OFFICE OF PETITIONS

In re Application of
Buskirk, et al. :
Application No. 09/942,537 :
Filing Date: 29 August, 2001 :
Attorney Docket No. RTI 143/1915-13879US01 :

This is a decision on the petition filed on 31 January, 2005, alleging unavoidable delay under 37 C.F.R. §1.137(a), and, in light of the allegations considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**, and the petition under 37 C.F.R. §1.137(a) is **DISMISSED as moot**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a “Notice of Drawing Inconsistency . . .” mailed on 15 December, 2004 (the 15 December Notice), with reply due under a non-extendable deadline on or before 15 February, 2005;
- the application went abandoned after midnight 15 February, 2005;
- it appears that the Office did not mail a Notice of Abandonment before the instant petition was filed;

- on 31 January, 2005, Petitioner filed the instant petition, with fee, and drawings (accompanied by an amendment under 37 C.F.R. §1.312 as his reply, and stated as his showing therein (with a declaration and supporting documents and his office protocols) that the 15 December Notice was not received until 18 January, 2005, after the deadline for reply.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶⁾⁾

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁷

Petitioner evidences receipt of the 15 December Notice after the due date of that Notice.

CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 hereby is **granted**, there appears to be is no Notice of Abandonment to be vacated; the petition under 37 C.F.R. §1.137(a) is **dismissed as moot**, and the petition fee (\$500.00) is waived, and \$1,500.00 authorize by Petitioner and charged by the Office (both in error) are refunded via Treasury check.

Pursuant to the provisions of OG Notice of 23 March, 2004, the Office of Patent Publications has the authority to waive the provisions of 37 C.F.R. §1.312 so as to accept the amendment required (e.g., as to drawings and consistency) without having to withdraw the application from issue.⁸

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

⁸ The OG Notice provides:

United States Patent and Trademark Office OG Notices: 23 March 2004

Waiver of 37 C.F.R. §1.312 for Documents Required by the Office of Patent Publication

In preparation of a patent for issuance as a patent grant, if the Office of Patent Publication discovers an error in the text, or drawings of a patent application, including any missing text, or an inconsistency between the drawings and the application papers, the Office of Patent Publication may require an appropriate amendment to the specification or drawings. 37 C.F.R. §1.312, however, does not permit an amendment after the payment of the issue fee without withdrawal of the application from issue.

In order to be able to accept such an amendment as may be required without having to withdraw an application from issue, the Office of Patent Publication is hereby delegated the authority to waive the requirement of 37 C.F.R. §1.312 and accept an amendment filed after the payment of the issue fee.

For information on this notice, contact the Office of Patent Publication at (703)305-8263.

February 24, 2004
STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy

The file is forwarded to Publications Branch to be processed into a patent in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 2727-3214.

A handwritten signature in black ink, appearing to be "J. Gillon, Jr.", with a large, stylized loop at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions